

### **REMARKS**

This Preliminary Amendment accompanies a Request for Continued Examination.

Please do not enter the Amendment After Final previously submitted on March 9, 2010, but rather, please enter and consider the present Preliminary Amendment.

A petition for one-month extension of time, and payment (by credit card authorization) for the requisite extension fees, and fees for four additional independent claims and four additional claims in excess of twenty, are submitted herewith. In the event any additional fees are necessary, kindly charge the cost thereof to our Deposit Account No. 13-2855.

### **Status of the Claims**

Claims 21-58 are pending in the present application, with claims 21-24 and 40-52 withdrawn. Claims 55-58 are introduced by the present Preliminary Amendment. Claims 25 and 36 are amended as described in more detail below. No new matter is added by the amended or additional claims of the present Preliminary Amendment.

### **Response to Rejections Under 35 U.S.C. § 102**

Claims 25, 27, 29, 31, 32, 36, 53 and 54 were rejected as anticipated by Hilton et al., EP 0 903 237 ("Hilton et al."). It is respectfully submitted that independent claims 25 and 36, as amended, as well as new claims 55-58, are patentably distinguishable over Hilton et al. Claim 25, as amended, recites a storage medium in the printing apparatus, and recites that the list of previously used identifiers (which is held in the storage medium) is arranged to be updated with identifiers of subsequent empty consumables accepted in the printing apparatus. According to Hilton et al., it is an identifier *in the consumable* which is updated, and there is no updating of *memory in the printing apparatus*.

Claim 36, as amended, recites two conditions of a printing apparatus, namely a first condition in which a processor arranged to compare the identifier read by the reader with the list of any previously used identifiers, upon determining that the consumable is a previously used and emptied consumable (by detecting a match between the identifier read by the reader and the list of previously used identifiers associated with empty consumables), generates an invalid indication including an internal control signal that does at least one of disables the printing apparatus or causes an error message to be displayed on a display of the printing apparatus; and a second condition in which the processor, upon determining that the consumable is not a previously used and emptied consumable (by detecting that there is not a match between the identifier read by the reader and the list of previously used identifiers associated with empty consumables), permits a printing operation.

Hilton, et al. do not show two such separate conditions. For example, according to amended claim 36, when there is a match of identifiers, printing is either disabled or an error message is displayed. When there is not a match, printing is permitted to continue normally. This directly contrasts with Hilton et al. (see column 9, lines 1-7), in which printing is performed only in a non-normal print mode when there is not a match of recognition numbers. There is no disclosure in the cited reference of disabling printing or causing an error message upon detection of a match.

According to new claims 56 and 57, the invalid indication includes an internal control signal which disables the printing apparatus such that printing operations cannot be implemented. In contrast to claim 25 (as amended), these claims do not include an option of an error message. These claims are also respectfully submitted to be patentably distinguishable

over Hilton, et al., in which printing operations can still be implemented (albeit in a non-normal print mode) when a consumable in an out-of-warranty condition is used.

Response to Rejections Under 35 U.S.C. § 103

Claims 26, 28, 30, 33-35 and 37-39 were also rejected as unpatentable over Hilton et al. in view of Klinefelter et al., WO 00/43932. The final Office action concedes that Hilton et al. does not teach an RF coil as the reader, but rather, teaches contact pads. According to the Office action, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the contact pads of Hilton et al. with the RF coil of Klinefelter et al., inasmuch as both references teach structure used for reading an identifier off a consumable. For the reasons discussed above, it is respectfully submitted that claims 25 and 36, as amended, are patentably distinguishable over Hilton et al. Even if Hilton et al. were modified according to, or combined with, Klinefelter et al. as proposed in the Office action, they would still not result in an updating of a storage medium *in the printing apparatus*, as recited in claim 25, as amended, as opposed to on a consumable. Furthermore, the modification or combination proposed in the Office action would not result in a combination of a printing apparatus and consumable wherein the printing apparatus includes a processor that, upon detection of a match of an identifier on the consumable and a list of previously used identifiers associated with empty consumables stored on a storage medium in the printing apparatus, generates an invalid indication that at least one of disables the printing apparatus or causes an error message to be displayed on a display of the printing apparatus, and upon detection of a mis-match, permits a printing operation. At best, the proposed combination or modification would still result in a system that, upon detection of a mismatch, causes the printer to print in a non-normal print mode. It is therefore respectfully

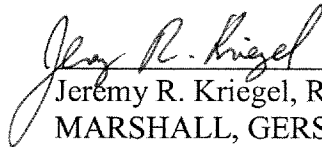
submitted that claims 25 and 36, and the claims depending therefrom, are allowable. Withdrawal of the rejection is respectfully solicited.

**Conclusion**

For the foregoing reasons, it is respectfully submitted that claims 25-39 and 53-58 are in condition for allowance. If the Examiner has any questions that might easily be resolved by telephone, he is invited to contact the Applicants' undersigned representative at (312) 474-6300.

Date: April 9, 2010

Respectfully submitted,



Jeremy R. Kriegel, Reg. No. 39,257

MARSHALL, GERSTEIN & BORUN LLP

233 South Wacker Drive, 6300 Sears Tower

Chicago, Illinois 60606

Tel. (312) 474-6300

Fax (312) 474-0448

Attorney for Applicants